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OFFICE OF PETITIONS

In re Application of
Jones, et al.
Application No. 09/590,592
Filed: June 8, 2000
Attorney Docket No. 252312007300

ON PETITION

This is a decision on the petitions, filed March 10, 2005, under 37 CFR 1.48(a) for correction of inventorship and under 37 CFR 1.183, requesting waiver of 37 CFR 1.48(a)(2), which requires a statement from the inventor being deleted (Fang Xie).

The petition under 37 CFR 1.48(a) is **dismissed**.

The petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RENEW THE PETITION WILL RESULT IN ABANDONMENT.** The reconsideration request should include a cover letter entitled "Renewed Petitions under 37 CFR §§ 1.48 and 1.183.

An executed declaration in compliance with 37 CFR 1.63 was filed on November 20, 2000. The fully executed declaration listed six joint inventors – David S. Jones, Huong-Thu Ton-Nu, Fang Xie, Anping Tao, Tong Xu, and Jeffrey Robert Hammaker.

The instant petitions were filed to correct the inventorship by deleting Inventor Fang Xie.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) a petition including a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (3) the fee set forth in 37 CFR 1.17 (i); and (4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

The petitions of record lack compliance with item (1).

This does not appear to be a situation in which the non-signing inventor cannot be located. Inventor Xie provided petitioners with a working telephone number for himself in China, as well as an e-mail address and a facsimile number. This appears to be a situation in which the non-signing inventor is constructively refusing to cooperate.

The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d).¹

The petition does not establish that a complete copy of the application was received by Inventor Xie. There is no assurance that Inventor Xie received the e-mail of WO 00/75105 or that the facsimile transmission of the claims for the above-identified application was successful.

When petitioners can show that Inventor Xie was successfully mailed or received/opened the complete application and that he either refused to sign the statement of lack of deceptive intent or would not respond to the request that he sign the statement within a reasonable period for response, petitioners will have met the requirements for waiver of 37 CFR 1.48(a)(2).

The petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) is dismissed.

Petitioners will not satisfy the requirements of 37 CFR 1.48(a) until petitioners file a grantable petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2). Thus, the petition under 37 CFR 1.48 is dismissed.

A review of financial records indicates that petitioners have been charged the Rule 48 processing fee. The 37 CFR 1.183 petition fee of \$400 is required and will be charged to deposit account No. 03-1952.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

¹ While this waiver petition is not a petition under 37 CFR 1.47, it is evaluated the same way a Rule 47 petition is with respect to inventor refusal to sign/cannot be reached issues.

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By FAX: (703) 872-9306 – ATTN: Office of Petitions

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3230.

A handwritten signature in black ink, reading "E. Shirene Willis". The signature is written in a cursive, flowing style.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions